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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REINER KRAFT and JUSSI PETRI MYLLYMAKI

Appeal 2008-2384
Application 09/783,666
Technology Center 2400

Decided: February 9, 2009

Before: ALLEN R. MACDONALD, ST. JOHN COURTENAY III and DEBRA K. STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1- 28. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-in-part and REVERSE-in-part.

Introduction

According to Appellant, the invention is a computer software program that transfers relevant stored information to a handheld device with limited memory (Spec. 1, ll. 14-20). Information is determined to be relevant based on an analysis of criteria related to a user's scheduled or current activities (Abstract).

Exemplary Claim(s)

Claim 1 is an exemplary claim and is reproduced below:

1. A method for automatic relevance-based preloading data to a computing device, comprising:

identifying any one or more of persons or current scheduled tasks prior to the occurrence of the tasks;

analyzing the relevance of stored data to any one or more of the current scheduled tasks or persons;

sorting the stored data based upon the relevance to any one or more of the current scheduled tasks or persons;

setting a predetermined relevance threshold;

automatically preloading selected sorted data to the computing device with a relevance score higher than the relevance threshold; and

wherein analyzing the relevance score comprises estimating a proximity of the stored data items to any one or more of persons or current scheduled tasks, based on an association proximity measure and at least one proximity measure.

Prior Art

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

DeLorme	US 5,948,040	Sept. 7, 1999
Liddy	US 6,026,388	Feb. 15, 2000

Rejections

The Examiner rejected:

Claims 11-28 under 35 U.S.C. § 101 for being directed to non-statutory subject matter;

Claims 19-20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;

Claims 19-20 under 35 U.S.C. §112, sixth paragraph for lacking written description necessary to support a claim limitation; and

Claims 1-28 under 35 U.S.C. § 103(a) as being unpatentable over DeLorme and Liddy.

GROUPING OF CLAIMS

Based on the arguments presented in Appellants' Brief, we decide the appeal of claims 1, 3-28 on the basis of arguments regarding claim 1. We decide the appeal of claim 2 on the basis of arguments regarding claim 1 and additional arguments regarding claim 2. Arguments Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

ISSUES

35 U.S.C. § 101: claims 11-28

Appellants agreed to the new rejection of claims 11-28 under 35 U.S.C. § 101 without the need to reopen prosecution in a telephone conference with the Examiner, June 9, 2005 (Ans. 11).[1] The Examiner rejected claims 11-28 for being directed to non-statutory subject matter (*id.*).

Have Appellants met the burden of showing the Examiner erred in rejecting claims 11-28 under 35 U.S.C. § 101?

35 U.S.C. §112, second paragraph: claims 19-20

The Examiner raised rejections of claims 19-20 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Ans. 12).

Issue: Have Appellants met the burden of showing the Examiner erred in rejecting claims 19-20 under 35 U.S.C. § 112, second paragraph?

35 U.S.C. § 112, sixth paragraph: claims 19-20

The Examiner additionally raised rejections of claims 19-20 under 35 U.S.C. § 112, sixth paragraph for lacking a written description necessary to support a claim limitation (Ans. 12-13).

[1] We note Appellants' Reply Brief of August 18, 2005 was filed in response to the Examiner's Answer filed July 5, 2005 which was subsequently vacated on December 11, 2006. Appellants did not then file a new Reply Brief in response to the Examiner's Answer filed August 23, 2007. Therefore, Appellants' Reply Brief has not been considered.

Issue: Have Appellants met the burden of showing the Examiner erred in rejecting claims 19-20 under 35 U.S.C. § 112, sixth paragraph?

35 U.S.C. § 103(a): claims 1-28

Appellants assert their invention is not obvious over the relevance score of Liddy being implemented into the system of DeLorme (Br. 8). Specifically, Appellants contend DeLorme does not provide setting a pre-determined relevance threshold since DeLorme does not compare a calculated relevance score of stored data to the relevance threshold (Br. 17). Appellants argue "threshold" implies a limit whereas DeLorme suggests a filter based on values being equal (Br. 17). DeLorme would load only if the data were exactly the "threshold" not higher than the threshold as Appellants' invention (Br. 27). Therefore, zip codes and area codes cannot be considered a threshold (Br. 17). Appellant further argues DeLorme does not disclose relevance score, and although Liddy may disclose this feature, combining the feature of Liddy into the system of DeLorme does not teach "automatically preloading selected sorted data to the computing device with a relevance score higher than the relevance threshold wherein analyzing the relevance score comprises estimating a proximity of the stored data items" (Br. 30-31).

The Examiner contends DeLorme teaches a predetermined threshold as the software provides supplemental or updated information on points of interest, with at least some points of interest topically classified or sorted – a well known technique in software and database art (Ans. 16). The Examiner admits DeLorme does not teach a relevance score but asserts Liddy teaches

relevance score. The Examiner then concludes combining the feature of Liddy into the system of DeLorme would have been obvious to provide an optimal trip planner that bases its proximity decision on a relevance score (Ans. 18).

Obviousness Issue 1: Have Appellants met the burden of showing the Examiner erred in finding DeLorme and Liddy taken together teach automatic preloading based on a relevance score higher than a relevance threshold?

Appellants additionally argue DeLorme does not disclose "estimating a proximity of the stored data items to any one or more of persons or current scheduled tasks, based on the combination of three proximity measures: distance, time, association" (claim 2). The Examiner contends that DeLorme discloses estimating based on a combination of three proximity measures: distance, time and association (Ans. 5).

Obviousness Issue 2: Have Appellants met the burden of showing the Examiner erred in finding DeLorme teaches estimating based on a combination of three proximity measures: distance, time and association?

FINDINGS OF FACT (FF)

DeLorme's Invention

(1) The software of DeLorme's invention provides a map display graphic user interface to enable a user to view maps at various levels of resolution and detail (col. 48, ll. 10-14). The user may locate named places, zip code or phone exchange areas, and street addresses or other landmarks on the map display (col. 48, ll. 14-19).

(2) The user may further view supplemental or updated information on points of interest on places near optimum computed travel routes with some points of interest topically classified (col. 48, ll. 19-23).

(3) If desired, the user may also add selected points of interest, and text, audio, and graphic information to his/her travel plans or map ticket based on provided multimedia travelog previews or presentations of points of interest with the area or region of the trip (col. 48, ll. 23-28). The software enables the user to prompt the multimedia preview or presentation on user selected types of points of interest located along a computed route (col. 48, ll. 47-67).

(4) The topically classified points of interest from the user-defined region or area around a previously computed route situated around a single location, a set of points or a computed route can be further sorted or filtered by topical, temporal and/or transactional criteria (col. 49, ll. 39-55).

(5) Thus, the map tickets or travel plans are constructed by combined user selection and computerized sorting processes with further topical, temporal, geographic and transaction "filters" or relational databases (col. 67, ll. 1-12). For example, if a user selects scuba diving and coral reefs using the software system, her map ticket output is "constructed" or "filtered" by sorting and selecting specific geographical places and/or dates/times for her trip based on already known information (e.g., days she will be in the geographic area) (col. 67, ll. 12-18).

(6) A user can further customize a travel plan by manipulating and adjusting selectable travel planning capabilities such as inputting preferences for transportation, times for travel, starting and ending locations, points of

interest, events or topics of interest, special offers, scheduling tools, information on selected topics, budget information and so forth (col. 17, ll. 14-43). Temporal information on events, travel times, etc. may also be included on a trip ticket (col. 22, ll. 19-37).

Liddy's Invention

(7) A system automatically sorts, ranks and displays documents determined to be relevant based on a calculated relevance score (col. 34, ll. 15-23).

(8) The relevance score is based on five sources of evidence (col. 21, ll. 61-65). These sources are used to compute five individual measures of similarity which are then combined to form a relevance score (*id.*).

PRINCIPLES OF LAW

Claim Construction

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). "Claims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.,* 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

"Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Obviousness

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966), stated that three factual inquiries underpin any determination of obviousness:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

ANALYSIS

35 U.S.C. § 101: claims 11-28;

Appellants agreed to the new rejection under 35 U.S.C. § 101; however, Appellants have not presented any arguments in response to the Examiner's rejections.

35 U.S.C. § 112, second paragraph: claims 19-20

The new rejection under 35 U.S.C. § 112, second paragraph of claims 19-20 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention were not addressed by Appellants. Indeed, no arguments were presented in response to the Examiner's rejection.

35 U.S.C. § 112, sixth paragraph: claims 19-20

A new rejection was also presented under 35 U.S.C. § 112, sixth paragraph. We *pro forma* reverse the Examiner's rejection as discussed in Footnote 2.[2]

[2] We note that it is improper to apply a § 112, sixth paragraph rejection. The proper rejection should be under §112, second paragraph (which we note was also added by the Examiner). Accordingly, we ***pro forma*** reverse the Examiner's rejection of claims 19-20 under 35 U.S.C. § 112, sixth paragraph.

35 U.S.C. §103(a): claims 1-28

Obviousness Issue 1

Appellants recite data is sorted and selected based on a relevance score higher than the relevance threshold (claim 1 and equivalent language in claims 11, 19, and 21). This sorted and selected data is then automatically loaded into a computing device (Spec. 10, ll. 1-11).

Appellants describe a system that automatically preloads a handheld device with information determined to be relevant (Abstract). Relevant information is preloaded based on whether its relevance score is higher than a relevance threshold (claims 1, 11, 19, and 21). Based on the record before us, we find the combination of the DeLorme with the relevance score feature of Liddy teaches or suggests automatically preloading selected sorted data based on a relevance score higher than a relevance threshold.

DeLorme teaches selecting data based on whether the data meets a specific feature or features (i.e., scuba diving, coral reefs and location X on date Y) (FF 5) or if the user specifically selects that point-of-interest (FF 3). Liddy teaches computing a relevance score for documents (FF 8). However, we find no teaching in DeLorme or Liddy that the information is automatically selected and loaded if the relevance score is higher than a relevance threshold.

In DeLorme, a user must choose the criteria, a sort or filtering is performed for data that matches that criteria, and the resulting data is provided to the user (FF 2 – FF 6). DeLorme does not teach or suggest a system or method that automatically loads relevant data into a device.

Liddy does not teach automatic preloading to another device based on the relevance score nor is data not higher than a relevance threshold filtered out.

Therefore, after considering the totality of the record before us, we find the weight of the evidence supports Appellants' contention that the Examiner has not sufficiently shown the correspondence between the claim elements and the relevant portions of the cited references to establish a prima facie case of obviousness. We find the gap between the combined teachings of the cited references to be uncomfortably wide and such gap cannot be bridged with theories or speculation. We find no specific teaching or suggestion in the Examiner's mapping to DeLorme and Liddy of automatic preloading based on a relevance score higher than a relevance threshold.

Obviousness Issue 2

Appellants define association as the people and contacts that are associated with the location and purpose of a given task (e.g., client meeting in a particular city) (Spec. 7, ll. 21-22). DeLorme does not teach or suggest using as association measure to determine whether to automatically pre-load data. The portions of DeLorme cited by the Examiner select data based on points of interest, events of interest, or temporal and geographic criteria (FF 5). DeLorme does not teach or suggest using an association measure. Moreover, DeLorme does not teach or suggest using distance, time and association to estimate a proximity.

Therefore, based on the record before us, we find DeLorme does not teach or suggest estimating a proximity based on the combination of three proximity measures: distance, time, and association. In particular we find DeLorme does not teach or suggest using an association measure and for us to affirm the Examiner on this record would require speculation on our part. We additionally find that Liddy does not overcome the deficiency of the primary DeLorme reference.

CONCLUSION OF LAW

We find Appellants have not met the burden of showing the Examiner erred in rejecting claims 11-28 under 35 U.S.C. § 101.

We find Appellants have not met the burden of showing the Examiner erred in rejecting claims 19-20 under 35 U.S.C. § 112, second paragraph.

We find the Examiner erred in rejecting claims 19-20 under 35 U.S.C. § 112, sixth paragraph.

We find Appellants met the burden of showing the Examiner erred in finding DeLorme and Liddy taken together disclose automatic preloading based on a relevance score higher than a relevance threshold. Additionally, we find DeLorme does not teach or suggest estimating a proximity based on the combination of three proximity measures: distance, time, and association.

Accordingly, we find Appellants have met the burden of showing the Examiner erred in rejecting claims 1-28 under 35 U.S.C. § 103(a) for obviousness over DeLorme and Liddy.

DECISION

The Examiner's rejection of claims 11-28 under 35 U.S.C. § 101 for being directed to non-statutory subject matter is affirmed.

The Examiner's rejection of claims 19-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is affirmed.

The Examiner's rejection of claims 19-20 under 35 U.S.C. § 112, sixth paragraph is reversed.

The Examiner's rejection of claims 1-28 under 35 U.S.C. § 103(a) as being obvious over DeLorme in view of Liddy is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART
REVERSED-IN-PART

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